

Remarks/Arguments

Claims 1, 3-15 are pending in the application. Claim 1 is the sole independent claim. Claim 1 has been amended and new claims 16 and 17 have been added.

I. Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1 and 3-15 were rejected under 35 U.S.C. §112, first paragraph, as being non-enabling for any chemical in a “solid slow-release form.” The Examiner states that while the specification is enabling for the slow release of a chemical in an encapsulated polymer or for delivering a scale inhibitor in the form of porous ceramic particles, it does not reasonably provide enablement for any chemical in a “solid slow-release form.”

Applicants respectfully disagree with the Examiner’s position and submit that the disclosure is enabling with respect to this limitation and that the Examiner is imposing an improper requirement upon Applicants.

Applicants would remind the Examiner that it is not necessary to enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment of the invention. *See* MPEP §2164, citing *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1338, 68 U.S.P.Q.2d 1940, 1944 (Fed. Cir. 2003). Moreover, detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. *See* MPEP §2164. Moreover, the amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. MPEP§ 2164.03 citing *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. MPEP§ 2164.03.

Applicants respectfully submit that the amount of knowledge in the state of the art relating to chemicals and methods for providing chemicals in a solid slow-release form, as claimed, is sufficiently great such that the enablement requirement has been met by Applicants’ disclosure. Furthermore, Applicants have given specific, but non-limiting,

examples of such methods, that provide guidance and direction to those skilled in the art as to the nature of the solid slow-release form. This could include the specific examples disclosed by Applicants as well as other solid materials which facilitate the slow release of chemicals from such solid. Other examples may include those solid materials or chemicals that have a low solubility in the well fluids such that the slow dissolution itself of the materials provides the slow release of the chemical. Those skilled in the art will readily recognize other examples and their preparation and use would not require undue experimentation such that the requirement of enablement has been met.

From Applicants' interpretation of the Examiner's rejection, the Examiner is placing an undue burden upon Applicants that require Applicants to essentially list every possible chemical and method that would provide a solid slow-release form in order for Applicants to obtain the broad coverage to which Applicants are entitled to. Applicants respectfully submit that this is an improper requirement.

For at least these reasons, Applicants respectfully submit that all the claims are enabled and the rejection of the claims on this basis should be withdrawn.

II. Rejections Under 35 U.S.C. §103(a)

Claims 1-5 and 7-13 were rejected under 35 U.S.C. §103(a), as being obvious based upon Wald (U.S. Patent No. 6,655,475), in view of Johnson (U.S. Patent No. 4,790,386). Claims 1-5 and 7-12 were also rejected as being obvious based upon Bruce (U.S. Patent No. 4,846,279), in view of Johnson. Claims 1, 2, 4 and 6-12 were rejected as being obvious based upon Burkhardt et al. (U.S. Patent No. 3,104,716), in view of Johnson. And claims 1 and 13-15 were rejected as being obvious based upon Moradi-Araghi (U.S. Patent No. 6,387,986) in view of either Wald, Bruce or Burkhardt, in view of Johnson, as applied above.

Applicants have noted that the Examiner has included claim 2 among the rejected claims in the Detailed Action. Claim 2 was canceled in the prior response, however.

None of the references cited and relied on by the Examiner provide a *prima facie* case of obviousness of the presently pending claims. In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim

limitations when combined. *See In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP §2143.03. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and MPEP §2143.01(III).

With respect to the combination of Wald and Johnson, both these references specifically disclose the use of degradable containers. See, for example, Wald at column 3, lines 49- 67, and Johnson at column 4, lines 31-62.

Applicants have specifically amended claim 1 to require that the container be non-degradable. Although the use of the term “non-degradable” is not specifically found in the specification, it is evident from the description that the basket is not intended to degrade. Indeed, as previously presented and now claimed in new claim 16, the basket may be reusable and re-fillable, such that it is clear that the container is non-degradable. Furthermore, nowhere have Applicants described that the container is a degradable container. If Applicants had meant for the container to be degradable, those skilled in the art would recognize this would have been specifically set forth. Applicants would also remind the Examiner that the subject matter of the claim need not have to be described *in haec verba* (i.e. using the same terms) in order for the disclosure to satisfy the description requirement. *See Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 56 U.S.P.Q.2d 1481 (Fed. Cir. 2000), *reh’g denied, reh’g, en banc, denied, Purdue Pharma L.P. v. Faulding, Inc.*, 2001 U.S.App. LEXIS 4469 (Fed. Cir. 2001). It is sufficient that the specification convey clearly to those skilled in the art, in any way, to whom it is addressed, that the applicants invented the subject matter that is later claimed. *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q.90, 97 (CCPA 1976), *appeal after remand*, 646 F.2d 527, 209 U.S.P.Q. 554 (CCPA 1981). An invention may be described in different ways and still be the same invention. *Kennecott Corp. v. Kyocera International, Inc.*, 835 F.2d 1419, 1422, 5 U.S.P.Q.2d 1194, 1197 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988).

Because both Wald and Johnson disclose a degradable container, the combination of Wald and Johnson fails provide a *prima facie* case of obviousness with respect to claim

1. The rejection of claim 1 and those claims depending upon it on this basis should therefore be withdrawn.

With respect to the combination of Bruce and Johnson, Bruce discloses a container that holds a liquid inhibitor and thus fails to provide a chemical in a solid slow-release form within the container. Additionally, the liquid of Bruce is released from a bladder 30 through a small capillary tube (see column 3, lines 53-62). Even combining a mesh material over an aperture, as the Examiner suggests with respect to Johnson, the bladder 30 does not allow any produced fluids to flow through the container. The apertures merely allow fluid to flow into the canister to compress the bladder 30. The flow of the fluid is therefore impeded. Applicants have amended claim 1 to specify that the produced fluids are not significantly impeded. This is supported in the specification, for instance, at paragraph 0013.

Accordingly, the combination of Bruce and Johnson fail to provide a *prima facie* case of obviousness with respect to claim 1 and those claims depending from it. The rejection on this basis should therefore be withdrawn.

With respect to the combination of Burkhardt and Johnson, no produced fluids are allowed to pass through the container 37 of Burkhardt. Indeed, water is only allowed to pass through permeable windows 40 and 48, which provide a low rate of flow (column 2, lines 39-44), and thus impede flow. Furthermore, produced oils are ejected through tube 51 and thus the container 37 cannot be said to allow un-impeded flow of these fluids. Neither does Johnson provide this missing element.

Accordingly, for at least these reasons, the combination of Burkhardt and Johnson fails to provide a *prima facie* case of obviousness with respect to claim 1 and those claims depending from it.

With respect to the combinations of Moradi-Araghi (U.S. Patent No. 6,387,986) in view of either Wald, Bruce or Burkhardt, in view of Johnson. Moradi-Araghi does not address the missing limitations previously discussed with respect to Wald, Bruce or Burkhardt, in view of Johnson. The recited combinations thus fail to provide a *prima facie* case of obviousness with respect to Applicants' claims and the rejection made upon this basis should be withdrawn.

Applicants have added new dependent claims 16 and 17, which are also believed to be allowable.

III. Conclusion

In light of the above remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

This response is being submitted within three months from the date of the office action. If any extension of time is believed necessary, however, such extension is hereby requested. The Commissioner is authorized to charge any additional required fee, or credit any excess fee paid, to Deposit Account 04-1579 (56.0719).

Respectfully submitted,



David L. Cate
Attorney for Applicants
Reg. No. 49,091

Date: Feb. 27, 2007
Schlumberger Technology Corporation
110 Schlumberger Drive, MD-1
Sugar Land, Texas 77478
Ph: (281) 285-4490
Fax: (281) 285-8569